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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5005.1065

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Signature [Signature]

Typed or printed name Oliver Platz

Application Number

10/705,489

Filed

November 11, 2003

First Named Inventor

Albrecht WEISS

Art Unit

2872

Examiner

Joshua L. Pritchett

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ attorney or agent of record. 40,833  
Registration number \_\_\_\_\_
- ☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

[Signature]

Signature

Erik R. Swanson

Typed or printed name

(212) 736 1940

Telephone number

January 19, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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Appl. No. 10/705,489  
January 19, 2006  
Reasons in Support of Pre-Appeal Brief Request for Review

Atty. Docket No. 5005.1065

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Re: Application of: Albrecht WEISS  
Serial No.: 10/705,489 Confirmation No.: 5102  
Filed: November 11, 2003  
For: MICROSCOPE, AND METHOD FOR MODIFYING THE  
LIGHT FLUX IN A MICROSCOPE  
Art Unit: 2872  
Examiner: Joshua L. Pritchett  
Customer No: 23280

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

January 19, 2006

**REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

In support of my Pre-Appeal Brief Request for Review filed on even date herewith in the above-identified application, Applicant hereby respectfully requests reconsideration of the application based on the following remarks.

REMARKS

Claims 1-27 are pending in the present application. Claims 1-5, 7 and 11-27 were rejected under 35 U.S.C. §102(b) as being anticipated by Leiter, U.S. Patent No. 5,022,744. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Leiter in view of Weiss, U.S. Patent App. Pub. No. 2003/0011910 A1. Claims 8-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Leiter.

Reconsideration of the application is respectfully requested.

Leiter describes a microscope in which a diaphragm 25 disposed in a lamp house 2 is used to keep illumination intensity constant when a filter 7, 8 is inserted to vary the color temperature of illuminating light. See col. 3, lines 1-4, and col. 3, line 65 to col. 4, line 3.

Weiss describes a method for regulating the brightness of a light source in which a change in the spectrum of the light emitted by the light source 2, due to a change in the electrical power delivered to the light source, is compensated for using a variable optical filter 16. See abstract.

Independent claims 1 and 19 recite an aperture device disposed in an illumination beam path for modifying the “numerical aperture” of the illuminating optical system and a light source control device for controlling, “upon [the changing] of the numerical aperture” by the aperture device, the light source so that “a light flux [passing] through the illuminating optical system remains substantially unchanged.”

It is respectfully submitted that the anticipation rejection represents clear error because the cited prior art reference, Leiter, fails to describe, expressly or inherently, every element as set forth in the claims. See MPEP 2131. Specifically, the cited prior art reference fails to teach the above-recited limitations of claims 1 and 19. Leiter does not modify the numerical aperture, nor control the light source upon the changing of the numerical aperture so as to maintain the light flux unchanged, as recited in claims 1 and 19. In contrast, Leiter merely changes the illumination light intensity using the diaphragm 25. The numerical aperture of the system is not changed. The term “numerical aperture” is well known to those

of ordinary skill in the art. As discussed in the present specification at paragraph [0003], a modification of the numerical aperture of the illuminating optical system causes a change in the resolution achievable with the optical imaging system and a change in the contrast of the image generated using the optical imaging system. The location of the diaphragm 25 of Leiter makes it clear that a change in the diaphragm would not change the numerical aperture. Because the diaphragm 25 is disposed upstream of the light guide 5 (see Fig. 1 of Leiter), a change in the diaphragm could not cause a change in the resolution of the imaging system or a contrast an image generated, as necessarily present upon a change in the numerical aperture.

Moreover, since Leiter does not change the numerical aperture, it cannot control the light source so that a light flux through the illuminating optical system remains substantially unchanged upon a change of the numerical aperture, as recited in claims 1 and 19. Even if one assumes that changing the diaphragm 25 of Leiter somehow does change the numerical aperture, which as discussed above cannot be the case, Leiter does not teach controlling the light source upon the changing of the numerical aperture so as to maintain the light flux unchanged, as recited in claims 1 and 19. In contrast, Leiter merely changes the diaphragm 25 itself to control the light source. Assuming that changing the diaphragm 25 somehow does change the numerical aperture, the light source is nevertheless not otherwise controlled to maintain the light flux upon a change in the diaphragm, as would be required to meet the limitations of claims 1 and 19.

Because Leiter fails to teach the above limitations of independent claims 1 and 19, anticipation of these claims, or any of their dependent claims, has not been established.

Regarding the obviousness rejection of dependent claim 6 based on a combination of Leiter with Weiss, Weiss does not teach or suggest the above-recited limitations of claims 1 and 19 missing from Leiter. Rather, Weiss merely describes regulating the brightness of the light source by changing the electrical power delivered to the light source so as to compensate the spectrum of the light. Therefore a combination of Leiter and Weiss, to the extent proper, could not render dependent claim 6 unpatentable.

Regarding the obviousness rejection of dependent claims 8-10 based on Leiter, Leiter

does not teach the above-recited limitations of independent claim 1. Nor does Leiter suggest those missing limitations. Therefore Leiter cannot render dependent claims 8-10 unpatentable for obviousness.

Withdrawal of the respective rejections of claims 1-5, 7 and 11-27 under 35 U.S.C. §102(b) based on Leiter, claim 6 under 35 U.S.C. §103(a) based on a combination of Leiter with Weiss, and claims 8-10 under 35 U.S.C. §103(a) based on Leiter, is respectfully requested.

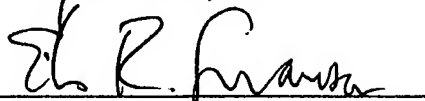
CONCLUSION

It is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By:



Erik R. Swanson, Reg. No. 40,833

Davidson, Davidson & Kappel, LLC  
485 Seventh Avenue, 14th Floor  
New York, New York 10018  
(212) 736-1940